

REMARKS

Upon entry of this Amendment, claims 1,3 and 7-9 remain in the application.

Claim 1 has been amended by this action.

The Office Action of March 3, 2006 has been received and carefully considered.

In response thereto, this Amendment is submitted. It is submitted that, as a result of this Amendment, all bases of rejection and objection are traversed and overcome. Reconsideration is, therefore, respectfully requested.

This Action is being submitted under the provisions of 37 C.F.R. § 1.116. It is submitted that the proposed amendments to the claims seek to place the claims in a condition suitable for allowance. It is also submitted that this action seeks to reduce the issues and claims that would have to be considered on Appeal.

At the outset, Applicant questions the finality of the most recent Office Action. The Applicant has presented valid points why the '437 reference was unavailable as prior art in this matter. Given the issues raised in the Office Action and the good faith attempts to address them in this response, withdrawal of finality and issuance of a new non-final Office Action is requested.

Initially, the Examiner has outlined various objections to the specification and claims. These have been addressed by this Amendment. It is submitted that this amendment overcomes the objections raised by the Examiner. Specifically, the Examiner indicated that in paragraph 32 of the specification, the language needs to be clarified as to what is meant by "only for a wood shaft" and what was meant by the phrase "up to at least 10 to 12 inches".

Claims 1, 3, 7, 8 and 9 stand rejected under 35 USC 102(b) as being anticipated or, in the alternative, under 35 USC 103(a) as obvious over McCarty '437. Claim 1 has been amended to specify that the shaft has a wall thickness between 0.005 and 0.01 inches. It is submitted that the McCarty references fails to teach or suggest a shaft wall thickness in the claimed ranges. Without being bound to any theory, it is believed that the McCarty reference fails to teach or suggest that the wall thicknesses in the range of 0.005 to 0.01 inches could provide that combination of low weight and rigidity desired in billiard cues unexpectedly discovered and outlined in the present application. Thus, it is submitted that the Applicant's

invention as set forth in claim 1 is not taught, anticipated or rendered obvious by the McCarty reference.

Support for claim 1 as amended is found in the specification as filed at paragraph 33 when viewed in conjunction with SN 08/314,864 (US Patent No 5,725,437, the McCarty reference.) The present application is a continuation-in-part of the daughter of US '437). The Examiner has indicated that US '437 does not disclose the thickness range of 0.005 to 0.01 inches. While the specification does not expressly state thickness in the range of 0.005 to 0.01 inches, this range can be inferred by the Applicant's filing of the CIP application.

Alternately, it is noted that the above-identified matter is a continuation-in-part application of the cited reference and, as such, is entitled to the benefit if the filing date of the cited reference for all disclosure common to with that earlier filed application. The Examiner contends that "the claims include features not disclosed in the '437 patent and that the filing date of the instant application is more than one year after the publication of the '437 patent, the '437 patent is available as prior art. (citing MPEP 201.11 VI.) Applicant questions the applicability of the cited section in the matter at hand. It is Applicant's understanding that MPEP 201.11VI pertains to claiming benefit to provisional applications filed in a language other than English. The Examiner is respectfully requested to explain the applicability of this section in the above-identified matter.

In the Office Action of 7/12/05, the Examiner has indicated that the present claims include features, such as wall thicknesses, not disclosed in the McCarty '437 the reference is available as prior art. In the following paragraph, the Examiner then that wall thicknesses of 0.01 inches or 0.015 inches are disclosed in McCarty '437. Either this feature is disclosed or it is not. Clarification of the apparent contradiction is requested. In the meantime, it is Applicant's position that the '437 reference is not available in this matter.

Claims 3 and 7-9 also stand rejected under 35 USC 102(b) as being anticipated or, in the alternative, under 35 USC 103(a) as obvious over McCarty '437. Claims 3 and 7-9 depend from claim 1 to contain all of the limitations found therein. By this dependency, it is submitted that the invention as set forth in claims 3 and 7-9 is not taught, anticipated or rendered obvious by the cited reference for the reasons discussed previously in conjunction with claim 1.

In summary, claim 1 has been amended by this action in a good faith effort to place the application in a condition suitable for allowance or in the alternative to reduce and clarify issues for consideration on appeal. Arguments and discussion have been presented as to why the Applicant's invention as set forth in claims 1, 3 and 7-9 is not taught, anticipated or rendered obvious by the cited reference and is in a condition suitable for allowance. A Notice of Allowance is respectfully requested. Alternately entry of this amendment for purposes of appeal is earnestly sought.

Respectfully submitted,

YOUNG, BASILE, HANLON, MacFARLANE,
WOOD & HELMHOLDT, P.C.



Denise M. Glassmeyer
Attorney for Applicant(s)
Registration No. 31831
(248) 649-3333
(248) 649-3338 (fax)
glassmeyer@ybpc.com

3001 West Big Beaver Road, Ste 624
Troy, Michigan 48084-3107

Dated: July 3, 2006
DMG/ljo